

**THIS DISPOSITION
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THE TTAB**

Mailed: September 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Richard Ferris

Serial No. 75589448

Richard Ferris, Pro Se.

Scott M. Oslick, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Walters, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Richard Ferris filed an application on the Principal Register to register the mark TEE-MAIL for, as amended, "wholesale and retail distributorship featuring golf equipment, golf and sport clothes, golf books, audio cassettes, video cassettes, compact disks and CD-ROMs which may be accessed by way of a global computer network," in International Class 35. The application was filed based

upon applicant's allegation of a bona fide intention to use the mark in commerce. A notice of allowance issued on June 27, 2000. Applicant filed his statement of use and specimen of use on June 25, 2002, alleging first use as of February 27, 1998, and first use in commerce as of January 28, 2002. Applicant subsequently submitted a supplemental specimen of use with a declaration.

The Examining Attorney has issued a final refusal on the ground that the specimens do not show use of the mark for the stated services, citing Trademark Rules 2.56 and 2.88(b)(2), 37 CFR §§2.56 and 2.88(b)(2). The Examining Attorney contends that the specimens of record show use of the mark in connection with goods, *i.e.*, golf clubs, not with the identified services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The specimens submitted in this case are excerpts from applicant's Internet website. The following pages are representative samples:



09/11/2003 11:22 755-288-0232 PERMIS FOLIOATION PAGE 03
100-MAIL TM Page 2 of 8



Too-Mail™ announces the introduction of

a

Revolutionary new golf putter handle

Much longer and wider than a traditional pliable putter grip, the patent pending Split Grip Handle measurably increases a player's putting accuracy.

The Split-Grip Handle conforms to USGA Rules and is made out of beautifully finished Oak, Ash, Hickory, Cherry or Walnut, putting wood, natural and beautiful, with all its warmth and feel, back into golf.... and this time into your hands.

Specifications of the golf putter handle and new split-hands grip putting technique:

Oversized width: Up to 1.750" (inches)

-Promotes increased control and accuracy. The gripping hands separated by the increased width of the handle's horizontal plane result in a decrease in wrist-flex tendencies.

<http://www.toomail.com/>

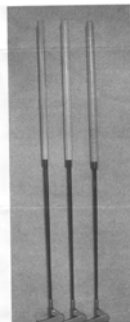
2/11/03

Received from <785280322> at 3/1/03 10:47:27 PM (Eastern Standard Time)

Too-Mail™

TM

Too-Mail™



<http://www.toomail.com/>

2/12/03



-More familiar and comfortable to golfers to whom this grip is ingrained.
-Severely reduces "wrist-flex" and the "yips". Promotes better control and consistency with this putting grip method than traditional putter handles (grips) designed only for a conjoined-hands grip.

Any design/type putter head with shaft attachment presently in common use can be employed in conjunction with the subject putter handle.

-A putter head with shaft attachment can be permanently fixed to the subject handle.
-A putter head with shaft attachment can be removable.
-A putter head with shaft attachment can be placed in one of several preset positions relative to the orientation of the subject putter handle. I.e. the direction of the putter face can be set parallel to or at 90 degrees to the median of the greatest diameter of the subject handle cross-section.

For information call or write Tee-Mail:
handle@teemail.com

<http://www.teemail.com/>

1/3/02

As supportive materials, applicant also submitted the results of a Google Internet search¹ and a letter from a customer who purchased from applicant the golf putter advertised on the Internet website.²

The Examining Attorney contends that the specimens do not show use of the mark in connection with applicant's

¹ The Google search results, including a reference to applicant, consist of such short excerpts that they are of very little value in determining any issue herein. Further, the excerpt referencing applicant is not evidence of use of the mark by applicant.

² The letter states that the signor purchased a golf putter from applicant after having first seen it on applicant's website. This letter is not probative of whether the mark, which we know is in use on applicant's website, is used as a service mark.

online wholesale and retail distributorship services; that "[t]he specimens make no mention of such services; nor do they infer usage of the mark for such services" (brief, p. 6); that, "[a]lthough the original specimen contained the wording 'for information call or write Tee-Mail: handle@teemail.com,' in the context of the entire specimen, potential consumers would most likely perceive this statement to refer to the goods described in the specimen, but not the applicant's online retail and wholesale distributorships" (*id.*); that the specimen shows only the mark with no reference to the identified services; that the mark will be perceived as identifying the golf clubs; that the Google Internet search results do not show use of the mark by applicant; and that applicant's use of a "TM" symbol rather than a "SM" symbol after the mark support the conclusion that the mark identifies goods rather than services.

Applicant contends that the specimen is acceptable evidence of service mark usage because it advertises the goods and includes a contact e-mail address that a prospective customer may use to obtain pricing information and to purchase the product and, thus, the services are inferred; that the Examining Attorney's refusal fails to understand applicant's commonly-employed marketing

strategy, which is considered a "soft" sales protocol because it invites the viewer to further communication, thus building a relationship which is crucial to, in particular, obtaining wholesale customers.

The issue before the Board is whether either specimen in this application is an acceptable specimen of use of the mark TEE-MAIL for the identified services. Section 45 of the Trademark Act, 15 U.S.C. §1127, contains the following definitions of "service mark" and "use in commerce," respectively:

Service mark. The term "service mark" means any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. ...

. . .

Use in commerce. The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce—

. . .

- (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the

United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Trademark Rule 2.56, 37 CFR §2.56, regarding the requirements for specimens reads, in pertinent part, as follows:

- (a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.
- (b) (2) A service mark specimen must show the mark as actually used in the sale or advertising of the services.

The courts and the Board have been quite clear that, in assessing the acceptability of materials which have been submitted as specimens of use, the facts and surrounding circumstances must be fully evaluated to determine the acceptability of preferred specimens. See, e.g., *Lands' End Inc. v. Manbeck*, 797 F.Supp. 311, 24 USPQ2d 1314 (E.D. Va. 1992). While the exact nature of the services does not need to be specified in the specimens, there must be something that creates in the mind of the purchaser an association between the mark and the service activity. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973); *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994), citing to *Intermed Communications Inc. v.*

Chaney, 191 USPQ 501 (TTAB 1977); and *In re Metriplex, Inc.* 23 USPQ2d 1315 (TTAB 1992). Further, when appropriate, the Board has been fairly flexible in accepting service mark specimens. See, e.g., *In re Ralph Mantia Inc.*, 54 USPQ2d 1284 (TTAB 2000); and *In re Metriplex Inc., supra*.

Contrary to the Examining Attorney's contentions, we find that the specimens are acceptable evidence of the use of the mark herein in connection with the services identified in the application. The mark appears on the website above a picture of the goods, where it appears to be the "title" of the web page. Additionally, in the text, reference is made to TEE-MAIL as an entity introducing a new product, not as the name of the product itself. The use of a "TM" rather than a "SM" is an understandable error that is likely to be of significance primarily to trademark law practitioners. The website is, essentially, an advertisement and it includes an e-mail address that uses the mark so that prospective wholesale or retail customers may contact applicant to discuss a distributorship agreement or to purchase products. Clearly, there is an association between the mark and the identified services. We conclude that each of the specimens of record is adequate to support the use of the mark in connection with the identified services.

Decision: The refusal to register on the ground that the specimens are unacceptable evidence of service mark use in connection with the identified services is reversed. The application will be forwarded for issuance of a registration in due course.